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No. 07-965

IN THE
# Supreme Court of the United States

MAURICE MITCHELL INNOVATIONS, L.P.,
*Petitioner,*

v.

INTEL CORPORATION,
*Respondent.*

**On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit**

## RESPONDENT'S BRIEF IN OPPOSITION

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## RULE 29.6 STATEMENT

Pursuant to Supreme Court Rule 29.6, respondent states that it has no parent companies or publicly held companies that own 10 percent or more of its stock.

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## RESPONDENT'S BRIEF IN OPPOSITION

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Respondent Intel Corporation respectfully asks this Court to deny the petition for writ of certiorari seeking review of the Federal Circuit's opinion in this case.

## STATEMENT OF THE CASE

1. Petitioner Maurice Mitchell Innovations, L.P. owns U.S. Patent No. 4,875,154 for a "Bimemory Independent CPU," also referred to as a "BICPU microcomputer." (Pet. 3a). The '154 patent purports to enable the construction of a singular, modular "switching unit" or "path configuring means" that interconnects the various components of a computer system. (Pet. 3a-6a, 14a). The patent further claims to include a "means for causing" the switching unit to remain in a "non signal-conducting state" when the system is powered up and to assume a "signal-conductive state" when given the appropriate signal. (Pet. 5a-6a, 15a n.2).

In 2000, petitioner sued Samsung in the Northern District of California for allegedly infringing Claim 1 of the '154 patent. *See Maurice Mitchell v. Samsung Electronics Co., Ltd.*, No. C-01-0295-SI (N.D. Cal. Jan. 29, 2002). After eighteen months of discovery, expert reports, extensive briefing, and a technical tutorial, Judge Susan Illston issued a claim construction order pursuant to this Court's decision in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). *Id.* Judge Illston held that four claim

limitations of Claim 1, including the "means for causing" limitation, were means-plus-function limitations as defined by 35 U.S.C. § 112 ¶ 6. *Id.*

Shortly after Judge Illston entered the *Markman* order, petitioner agreed to dismiss its case against Samsung on the condition that the court vacate the *Markman* order. *Id.* Judge Illston refused. Nonetheless, petitioner later dismissed its suit. *Id.*

2. Petitioner then sued Intel in the Eastern District of Texas in December of 2004, alleging that a number of Intel's products violated Claim 1 of the '154 patent. (Pet. 14a). After two years of litigation and another *Markman* hearing, the court agreed with Judge Illston's analysis in the *Samsung* case and likewise construed several claim terms as means-plus-function limitations. (Pet. 15a); *Maurice Mitchell Innovations, L.P. v. Intel Corp.*, No. 2:04-CV-450, slip op. (E.D. Tex. June 21, 2006). The court deferred for disposition on summary judgment the issue of whether the patent's written specification sufficiently disclosed corresponding structures for three of the means-plus-function limitations in Claim 1, as required by § 112 ¶ 6. (Pet. 15a).

After considering briefing on that issue, the district court held that the patent specification did not disclose corresponding structures for the three claim limitations. (Pet. 13a-28a); *Maurice Mitchell Innovations, L.P. v. Intel Corp.*, No. 2:04-CV-450, slip op. (E.D. Tex. June 21, 2006). The court therefore issued an unpublished opinion granting summary judgment for Intel on the ground that Claim 1 of the

'154 patent was invalid as indefinite under 35 U.S.C. § 112 ¶¶ 2 & 6. *Id.*

In finding that the "means for causing" limitation lacked corresponding structure, the court considered the specification as a whole, but specifically discussed two parts of the specification highlighted by petitioner: a passage at columns 24:67-25:56 and a reference to a microchip, MCS-6520. (Pet. 23a-28a). With respect to the cited passage, the court found that the passage contained no reference to structure. (Pet. 24a). The court noted that "even Mitchell recognizes that the passage describes the operation of the switch means, but does not disclose any structure." *Id.*; *see also* (Pet. 26a n.8) (quoting counsel for petitioner who stated: "There is no specific detailed structure set out in the specification."). It also disagreed with petitioner's suggestion, presented in supplemental post-hearing briefing, that a person of skill in the art reading this passage would know that the corresponding structure could be "the control elements of the tri-state devices" or a "tri-state driver." (Pet. 27a-28a). The court observed that neither this passage nor the specification contained any reference to "tri-state circuitry, control elements, or any other structure." (Pet. 26a-28a, 20a).

As for the MCS-6520 microchip, the court found that nothing in the specification linked the chip to the "means for causing" claim limitation. (Pet. 24a-25a). The court further remarked that the MCS-6520 was not itself a driver; it was a "whole chip" with several thousand transistors that might contain

the alleged tri-state driver. (Pet. 24a-25a). This, the court held, was insufficient under § 112 ¶ 6.

3. Petitioner appealed, but the Court of Appeals for the Federal Circuit affirmed in a unanimous unpublished decision, agreeing with the district court that the specification did not disclose a corresponding structure for the "means for causing" limitation. (Pet. 1a-11a); *Maurice Mitchell Innovations, L.P. v. Intel Corp.*, 249 Fed. Appx. 184 (Fed. Cir. Sept. 24, 2007). In so holding, the court of appeals not only examined columns 24:67-25:56 but also concluded that the specification disclosed no specific structure "anywhere." (Pet. 9a). With respect to the MCS-6520 chip, the court held that "[t]he mere mention of a complicated integrated circuit, comprised of hundreds, if not thousands of circuits, is much too broad to sufficiently indicate the precise 'means for causing' structure to a person of ordinary skill in the art." (Pet. 10a).

Petitioner then filed a Petition for Panel Rehearing and Rehearing En Banc, which the Federal Circuit unanimously denied on November 5, 2007. (Pet. 38a-39a).

Petitioner has now filed a petition for a writ of certiorari with this Court, which was docketed on January 23, 2008.

## REASONS FOR DENYING THE PETITION

Petitioner purports to present two questions regarding summary judgment procedure. In actuality,

however, the petition asks the Court to review the lower courts' unpublished and therefore nonprecedential application of settled and properly stated law to the particular facts of this case. Under Supreme Court Rule 10, certiorari is plainly unwarranted. In any event, petitioner's complaints are meritless: the lower courts properly determined that the claim at issue is invalid for indefiniteness because the specification failed to disclose corresponding structure as required by 35 U.S.C. § 112 ¶ 6.

## I. Petitioner presents no issue capable of satisfying Rule 10 and seeks reversal based only on alleged factual errors.

None of the grounds for granting certiorari are present in this case. The decision of the Federal Circuit does not create a circuit split on an "important matter." Sup. Ct. R. 10(a). It does not decide an important federal question in a way that conflicts with a decision of this Court. Sup. Ct. R. 10(c). It does not decide an important federal question that has not been, but should be, settled by this Court. *Id.* And it certainly does not "so far depart from the accepted and usual course of judicial proceedings . . . as to call for an exercise of this Court's supervisory powers." Sup. Ct. R. 10(a). Rather, this petition falls squarely within Rule 10's admonishment that "a petition for a writ of certiorari is rarely granted when the asserted error consists of erroneous factual findings or the misapplication of a properly stated rule of law." Sup. Ct. R. 10.

### A. The Federal Circuit's unpublished decision recites and adheres to long-established summary-judgment standards.

The petition's first Question Presented asks "[w]hether the legal standard for surviving summary judgment requires the non-movant to prove the merits of its case, rather than proving only the existence of a genuine issue of material fact." (Pet. i).

The answer, well known to any first-year law student, is "no." There is not even a whiff of controversy about this so-called "Question" anywhere in the federal system, to the best of respondent's knowledge. More importantly, none was created by the Federal Circuit's unanimous unpublished opinion below, which properly articulated and adhered to the long-established standard. Indeed, both courts below correctly recited the summary judgment standard at the outset of their respective opinions. (Pet. 16a) (citing *Celotex Corp. v. Catrett*, 447 U.S. 317, 323-25 (1986); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986); *Matsushita Elec. Indus. Co. v. Zenith Radio*, 475 U.S. 574, 587 (1986)); (Pet 7a).

Unable to cite any *misstatement* of the standard, petitioner argues instead that the courts below *misapplied* the standard because they supposedly "ignored unrebutted evidence." (Pet. 6-14). The evidence that the four judges all supposedly "ignored" was the testimony of petitioner's expert, Dr. Patterson, who stated that the MCS-6520 chip and the passage at columns 24:67-25:56 of the specification

disclose a structure for the "means for causing" limitation. (Pet. 10-14). This fallback argument is nothing more than a call for reversal based on alleged factual error.

In any event, neither court ignored the evidence in question. Indeed, both courts explicitly considered the sections relied on by Dr. Patterson. (Pet. 8a-11a, 23a-28a). The Federal Circuit agreed with the district court that a "mere mention" of the MCS-6520 chip—"a complicated integrated circuit comprised of hundreds, if not thousands of circuits"—was too broad to serve as sufficient structure. (Pet. 10a). Both courts likewise agreed with and adopted petitioner's admission that the passage at columns 24:67-25:56 merely described an operation and therefore failed to reveal any structure. (Pet. 9a) (crediting the district court's finding that counsel for petitioner admitted during the summary judgment hearing that this passage does not include any structure linked to the claimed function); (Pet. 24a) (noting that even petitioner acknowledged that the passage describes the operation of the switch means, but does not disclose structure). Thus, the lower courts properly considered all evidence under the summary judgment standard as announced by this Court.

In sum, the crux of this petition is simply that the Federal Circuit should have found corresponding structure in the specification. Resolving this question does not require re-examining the familiar summary-judgment standard—a standard that has been settled for decades and that was properly ar-

ticulated and applied in this case. The petition should be denied because it merely asserts that the Federal Circuit "misappli[ed] . . . a properly stated rule of law." Sup. Ct. R. 10.

### B. The Federal Circuit's decision recites and adheres to the established "person of ordinary skill in the art" standard for identifying corresponding structure in the patent specification.

The second Question Presented by the petition asks "[w]hether a court may properly grant summary judgment of patent invalidity based upon its own understanding of the patent claims and specification, without reference to record evidence regarding the understanding of a person of skill in the art of the patent." (Pet. i).

This second "Question" rivals the first in its obviousness. The answer is "no." As everyone versed in patent law knows, a court applies the viewpoint of a person of ordinary skill in the art, or "POSITA," in determining whether the specification discloses sufficient structure corresponding to a means-plus-function claim limitation.

That is exactly what the lower courts did here. The court of appeals observed that § 112, ¶ 6 "requires more than just the possibility that an artisan of ordinary skill may be able to figure out the corresponding structure. The quid pro quo for using a means-plus-function limitation requires specificity in reciting structure and linking that structure to the

limitation." (Pet 11a). Applying the POSITA standard, the Federal Circuit concluded that "[t]he mere mention of a complicated integrated circuit, comprised of hundreds, if not thousands of circuits, is much too broad to sufficiently indicate the precise 'means for causing' structure to a person of ordinary skill in the art." (Pet. 10a)

Having failed again to identify any misstatement of the governing law, petitioner once again falls back on an argument that the court of appeals misapplied the law. Petitioner again asserts that the Federal Circuit improperly ignored testimony of Dr. Patterson in making its POSITA finding. (Pet. 15-17). This Court, however, does not grant certiorari on arguments that the lower court "misappli[ed] . . . a properly stated rule of law." Sup. Ct. R. 10. Petitioner merely seeks reversal based on alleged factual error here and accordingly fails to present any "compelling reason" to grant the petition. Sup. Ct. R. 10.

## II. Petitioner's claims of error are nevertheless meritless.

Even if one could overlook the failure to satisfy any Rule 10 criterion, petitioner's claims of error lack merit.

A patent specification must contain "one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112 ¶ 2. Under 35 U.S.C. § 112 ¶ 6, if an applicant "employs means-plus-function language in a claim, one must set forth

in the specification an adequate disclosure showing what is meant by that language." *In re Donaldson*, 16 F.3d 1189, 1195 (Fed. Cir. 1994). Thus, while paragraph 6 permits applicants to employ means-plus-function language in a claim, Congress attached an express condition to this privilege: the specification must disclose a corresponding structure to the means-plus-function claim limitation. *Valmont Industries, Inc. v. Reinke Mfg. Co., Inc.*, 983 F.2d 1039, 1042 (Fed. Cir. 1993) (describing this condition, in the context of the legislative history, as the "attached string"); *see also Default Proof Credit Card Sys. v. Home Depot U.S.A., Inc.*, 412 F.3d 1291, 1298 (Fed. Cir. 2005) ("A structure disclosed in the specification qualifies as 'corresponding' structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim."). *See generally Halliburton Oil Well Cementing Co. v. Walker*, 239 U.S. 1 (1946), *superseded by statute*, 35 U.S.C. § 112 ¶ 6. If the specification fails to disclose a corresponding structure, the claim is invalid for indefiniteness. *Biomedino, L.L.C. v. Waters Technologies Corp.*, 490 F.3d 946, 950 (Fed. Cir. 2007); *see also United Carbon v. Binney & Smith*, 317 U.S. 228, 237 (1942).

Claim 1 includes a "means for causing" a switching unit to assume and remain in "signal-conducting" and "non-signal-conducting" states at various times and in response to various stimuli. (Pet. 5a-6a, 15a n.2). It is undisputed that this "means for causing" claim limitation is properly considered a means-plus-function claim limitation.

(Pet. 15a). Accordingly, the '154 specification must disclose structure capable of performing those functions and clearly link the structure to them. If the specification fails to do so, Claim 1 is invalid as indefinite.

The '154 specification nowhere discloses structure for performing the "signal-conducting" or the "non-signal-conducting" functions. Throughout this case, and now on petition to this Court, petitioner has relied on two unrelated sections of the specification: columns 24:67-25:56 and a reference to an MCS-6520 microchip. According to petitioner, these sections reveal a "tri-state driver" capable of performing the "signal-conducting" and "non-signal-conducting" functions. In fact they do no such thing.

First, the cited columns at most describe, in general terms, the *functions* of the limitation; there is no reference to a *structure for achieving those functions.* (Pet. 26a n.9). Most revealingly, there is no reference to a "tri-state driver" anywhere in the passage. (Pet. 26a n.9). Indeed, the word "tri-state" appears *nowhere* in the patent specification. (Pet. 20a). Counsel for petitioner even *admitted* below that the passage describes a function and does not disclose any structure. (Pet. 24a); *see also* (Pet. 26a n.8).

Second, mere reference to the MCS-6520 chip as a whole, without more specificity, cannot support a finding of structure. The specification fails to articulate the necessary link between the chip and the "signal-conducting" or "non-signal conducting" functions. (Pet. 10a). The MCS-6520 is an entire chip

containing several thousand circuits that may or may not contain a "tri-state driver" capable of achieving the "means for causing" functions. *Id.* Petitioner's argument that reference to an entire prior art chip, with nothing more, is sufficient corresponding structure for an allegedly novel "means for causing" contravenes the statutory mandate of paragraph 6 that an applicant clearly link the structure disclosed in the specification to the function of the claim limitation. *See* 35 U.S.C. § 112 ¶ 6; *see also Default Proof*, 412 F.3d at 1298 (requiring that the specification "clearly link" disclosed structure to the function recited in the claim).

Existence of the requisite corresponding structure for a means-plus-function claim limitation is a question of law. *AllVoice Computing PLC v. Nuance Comm., Inc.*, 504 F.3d 1236, 1240-41 (Fed. Cir. 2007); *see also Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996) (interpretation and construction of patent claims is a matter of law). Petitioner's insistence that conclusory expert testimony, without more (and even contrary to the weight of the repeat admissions and other evidence), must necessarily create a genuine issue of material fact on a legal question actually contravenes the standard for summary judgment announced by this Court. *See, e.g., Anderson*, 477 U.S. at 248 (providing that a court may grant summary judgment where the evidence demonstrates no genuine issue of material fact). Indeed, this Court found no disputed question of material fact where an "expert provides a conclusory affidavit" to address an ultimately legal deter-

mination. *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1745-1746 (2007). Here, Dr. Patterson's unsupported assertion that the specification discloses corresponding structure cannot create a genuine issue of material fact in the face of overwhelming evidence to the contrary. Accordingly, under this Court's standard for summary judgment, the claim is invalid.

Petitioner's claims of error are therefore meritless.

## CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Respectfully submitted,

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